

R E M A R K S

Claims 1-37 were pending in the application. Claims 1-18 and 31-37 have been elected for examination. Claims 19-30 have been withdrawn. Of the elected claims, claims 1, 31-32 and 35-37 are independent claims. No new matter has been added by this amendment.

Applicants respectfully submit that the present application is in condition for allowance. Accordingly, reconsideration and allowance of the present application are respectfully requested.

Restriction/Election

Claims 1-37 were subject to a restriction requirement. In particular, restriction to one of the following inventions was required:

- | | |
|-----------|--|
| Group I | Claims 1-18 and 31-37 drawn to a business method for upgrading a private label account to a dual card account, which can be routed and used with existing bankcard and payment card networks and processing platforms, classified in class 705, subclass 35. |
| Group II | Claims 19-23, drawn to a method for applying for a new dual card account within the context of a purchase transaction and performing credit analysis, classified in class 705, subclass 38. |
| Group III | Claims 24-30, drawn to a method for activating a dual card, classified in class 705, subclass 44. |

In response to the restriction requirement, Applicants elected Group I (claims 1-18 and 31-37).

Nonstatutory Double-Patenting Rejections

Claims 31-34 are rejected under the judicially created doctrine of the obviousness-type double patenting.

Applicants respectfully request that the rejections under the judicially created doctrine of the obviousness-type double patenting be held in abeyance until allowable subject matter is indicated.

Claims 31-34

As stated above, claims 31-34 are rejected under the judicially created doctrine of the obviousness-type double patenting.

Although not specifically stated in the Office Action, claims 31-34 appear to be otherwise allowable.

Accordingly, confirmation that claims 31-34 are otherwise allowable is respectfully requested.

Claim Rejections – 35 USC § 102

Claims 1-4 and 16 are rejected under 35 U.S.C. 102(b) as being unpatentable over “The fight for retail credit”. Credit Card Management, 13(9), 40-45(2000, December) by Jason Fargo (Fargo).

Reconsideration and withdrawal of the rejections is respectfully requested.

Claim 1

Claim 1 recites a method, comprising: selecting a private label account maintained on a first processing platform for upgrade to a dual card account, said private label account associated with an account holder and having associated monetary and non-monetary data; creating said dual card account with a zero balance on a second processing platform; transferring said non-monetary data associated with said private label account to said second processing platform for association with said dual card account; and causing a dual card associated with said dual card account to be transmitted to account holder, said dual card and said dual card account being inactive until activated.

Fargo does not teach or suggest the method of claim 1.

Fargo states that Sears, Roebuck and Co., the nation's largest store card issuer, began moving some 7 million inactive holders of its proprietary card to cobranded Sears MasterCard.

However, such statement does not teach or suggest selecting a private label account maintained on a **first processing platform** for upgrade to a dual card account and creating said dual card account on a **second processing platform**.

The Office Action asserts that in converting proprietary card accounts to co-branded accounts, non-monetary data would be transferred from the previous processing platform to the new platform of the issuing bank (see Office Action, page 7, final line-page 8, first line).

Applicants respectfully disagree.

The mere statement that inactive holders of the proprietary card are moved to cobranded Sears MasterCards cannot possibly stand for a universal proposition that teaches selecting a private label account maintained on a **first processing platform** for upgrade to a dual card account and creating said dual card account on a **second processing platform**.

Indeed, if the position of the Office Action is that selecting a private label account maintained on a first processing platform for upgrade to a dual card account and creating said dual card account on a second processing platform is inherent in moving inactive holders to cobranded Sears MasterCards, Applicants respectfully submit that such position is improper (see MPEP 2112 (IV) " 'to establish inherency, the extrinsic **evidence must make clear that the missing descriptive matter is necessarily present**' . . . [i]nherency . . . **may not be established by probabilities or possibilities**' ", citing In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)) (emphasis added).

For at least the reasons above, Fargo does not teach or suggest a method, comprising: selecting a private label account maintained on a first processing platform for upgrade to a dual card account, said private label account associated with an account holder and having associated monetary and non-monetary data; creating said dual card account with a zero balance on a second processing platform; transferring said non-monetary data associated with said private label account to said second processing platform for association with said dual card account; and causing a dual card associated with said dual card account to be transmitted to account holder, said dual card and said dual card account being inactive until activated, as recited in claim 1.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

In the event that the Examiner decides to repeat the rejection in view of Fargo, the Examiner is kindly requested to provide a **new non Final Office Action** that explains, **with particularity, why the missing descriptive matter is necessarily present.**

Claim Rejections – 35 USC § 103

Claims 35-37 are rejected under U.S.C. 103(a) as being unpatentable over the “The fight for retail credit”, Credit Card Management, 13(9), 40-45(2000, December) by Jason Fargo (Fargo) in view of in view of U.S. Publication No. 2004/0049452 A1 (Blagg).

Reconsideration and withdrawal of the rejections is respectfully requested.

Claim 35

Claim 35 recites a payment card processing apparatus, comprising: a processor; and a storage device in communication with said processor and storing instructions adapted to be executed by said processor to: select a private label account maintained on a first processing platform for upgrade to a dual card account, said private label account associated with an account holder and having associated monetary and non-monetary data; create said dual card account with a zero balance on a second processing platform; transfer said non-monetary data associated with said private label account to said second processing platform for association with said dual card account; and cause a dual card associated with said dual card account to be transmitted to account holder, said dual card and said dual card account being inactive until activated.

Neither Fargo, nor Blagg nor any combination thereof proposed in the Office Action teaches or suggests the payment card processing apparatus of claim 35.

As stated above, Fargo states that Sears, Roebuck and Co., the nation's largest store card issuer, began moving some 7 million inactive holders of its proprietary card to cobranded Sears MasterCard.

However, such statement does not teach or suggest selecting a private label account maintained on a first processing platform for upgrade to a dual card account and creating said dual card account with a zero balance on a second processing platform.

The mere statement that inactive holders of the proprietary card are moved to cobranded Sears MasterCards cannot possibly stand for a universal proposition that teaches selecting a private label account maintained on a first processing platform for upgrade to a dual card account and creating said dual card account on a second processing platform.

Indeed, if the position of the Office Action is that selecting a private label account maintained on a first processing platform for upgrade to a dual card account and creating said dual card account on a second processing platform is inherent in moving inactive holders to cobranded Sears MasterCards, Applicants respectfully submit that such position is improper (see MPEP 2112 (IV) " 'to establish inherency, the extrinsic **evidence must make clear that the missing descriptive matter is necessarily present**' . . . [i]nherency . . . **may not be established by probabilities or possibilities**" , citing In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)) (emphasis added).

Blagg discloses a multiple credit line presentation instrument (title).

However, Blagg does not teach or suggest selecting a private label account maintained on a first processing platform for upgrade to a dual card account; creating said dual card account with a zero balance on a second processing platform; and causing a dual card associated with said dual card account to be transmitted to account holder.

For at least the reasons above, neither Fargo, nor Blagg nor any combination thereof proposed in the Office Action teaches or suggests a payment card processing apparatus, comprising: a processor; and a storage device in communication with said processor and storing instructions adapted to be executed by said processor to: select a private label account maintained on a first processing platform for upgrade to a dual card account, said private label account associated with an account holder and having associated monetary and non-monetary data; create said dual card account with a zero balance on a second processing platform; transfer said non-monetary data associated with said private label account to said second processing platform for association with said dual card account; and cause a dual card associated with said dual card account to be transmitted to account holder, said dual card and said dual card account being inactive until activated, as recited in claim 35.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

In the event that the Examiner decides to repeat the rejection in view of Fargo and Blagg, the Examiner is kindly requested to provide a **new non Final Office Action** that explains, **with particularity, why the missing descriptive matter is necessarily present.**

Claim 36

Claim 36 recites a payment card processing system, comprising: means for selecting a private label account maintained on a first processing platform for upgrade to a dual card account, said private label account associated with an account holder and having associated monetary and non-monetary data; means for creating said dual card account with a zero balance on a second processing platform; means for transferring said non-monetary data associated with said private label account to said second processing platform for association with said dual card account; and means for causing a dual card associated with said dual card account to be transmitted to account holder, said dual card and said dual card account being inactive until activated.

Neither Fargo, nor Blagg nor any combination thereof proposed in the Office Action teaches or suggests the payment card processing system of claim 36.

As stated above, Fargo states that Sears, Roebuck and Co., the nation's largest store card issuer, began moving some 7 million inactive holders of its proprietary card to cobranded Sears MasterCard.

However, such statement does not teach or suggest selecting a private label account maintained on a first processing platform for upgrade to a dual card account and creating said dual card account with a zero balance on a second processing platform.

The mere statement that inactive holders of the proprietary card are moved to cobranded Sears MasterCard cannot possibly stand for a universal proposition that teaches selecting a private label account maintained on a first processing platform for upgrade to a dual card account and creating said dual card account on a second processing platform.

Indeed, if the position of the Office Action is that selecting a private label account maintained on a first processing platform for upgrade to a dual card account and creating said dual card account on a second processing platform is inherent in moving inactive holders to cobranded Sears MasterCard, Applicants respectfully submit that such position is improper (see

MPEP 2112 (IV) " 'to establish inherency, the extrinsic **evidence must make clear that the missing descriptive matter is necessarily present**" . . . [i]nherency . . . **may not be established by probabilities or possibilities**" , citing In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)) (emphasis added).

Blagg discloses a multiple credit line presentation instrument (title).

However, Blagg does not teach or suggest selecting a private label account maintained on a first processing platform for upgrade to a dual card account; creating said dual card account with a zero balance on a second processing platform; and causing a dual card associated with said dual card account to be transmitted to account holder.

For at least the reasons above, neither Fargo, nor Blagg nor any combination thereof proposed in the Office Action teaches or suggests a payment card processing system, comprising: means for selecting a private label account maintained on a first processing platform for upgrade to a dual card account, said private label account associated with an account holder and having associated monetary and non-monetary data; means for creating said dual card account with a zero balance on a second processing platform; means for transferring said non-monetary data associated with said private label account to said second processing platform for association with said dual card account; and means for causing a dual card associated with said dual card account to be transmitted to account holder, said dual card and said dual card account being inactive until activated, as recited in claim 36.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

In the event that the Examiner decides to repeat the rejection in view of Fargo and Blagg, the Examiner is kindly requested to provide a **new non Final Office Action** that explains, **with particularity, why the missing descriptive matter is necessarily present.**

Moreover, the Office Action states that the Examiner does not treat claim 36 as invoking 35 USC § 112 paragraph 6 because the claim provides a list of structures, material or acts for achieving the specified function.

Applicants respectfully submit that the treatment in regard to claim 36 is improper.

Applicants respectfully request that claim 36 be treated as invoking 35 USC § 112 paragraph 6.

Claim 37

Claim 37 recites a medium storing instructions adapted to be executed by a processor to perform a payment card processing method, said method comprising: selecting a private label account maintained on a first processing platform for upgrade to a dual card account, said private label account associated with an account holder and having associated monetary and non-monetary data; creating said dual card account with a zero balance on a second processing platform; transferring said non-monetary data associated with said private label account to said second processing platform for association with said dual card account; and causing a dual card associated with said dual card account to be transmitted to account holder, said dual card and said dual card account being inactive until activated.

Neither Fargo, nor Blagg nor any combination thereof proposed in the Office Action teaches or suggests the medium of claim 37.

As stated above, Fargo states that Sears, Roebuck and Co., the nation's largest store card issuer, began moving some 7 million inactive holders of its proprietary card to cobranded Sears MasterCards.

However, such statement does not teach or suggest selecting a private label account maintained on a first processing platform for upgrade to a dual card account and creating said dual card account with a zero balance on a second processing platform.

The mere statement that inactive holders of the proprietary card are moved to cobranded Sears MasterCards cannot possibly stand for a universal proposition that teaches selecting a private label account maintained on a first processing platform for upgrade to a dual card account and creating said dual card account on a second processing platform.

Indeed, if the position of the Office Action is that selecting a private label account maintained on a first processing platform for upgrade to a dual card account and creating said dual card account on a second processing platform is inherent in moving inactive holders to cobranded Sears MasterCards, Applicants respectfully submit that such position is improper (see MPEP 2112 (IV) " 'to establish inherency, the extrinsic **evidence must make clear that the**

missing descriptive matter is necessarily present" . . . [i]nherency . . . **may not be established by probabilities or possibilities'** ", citing In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)) (emphasis added).

Blagg discloses a multiple credit line presentation instrument (title).

However, Blagg does not teach or suggest selecting a private label account maintained on a first processing platform for upgrade to a dual card account; creating said dual card account with a zero balance on a second processing platform; and causing a dual card associated with said dual card account to be transmitted to account holder.

For at least the reasons above, neither Fargo, nor Blagg nor any combination thereof proposed in the Office Action teaches or suggests a medium storing instructions adapted to be executed by a processor to perform a payment card processing method, said method comprising: selecting a private label account maintained on a first processing platform for upgrade to a dual card account, said private label account associated with an account holder and having associated monetary and non-monetary data; creating said dual card account with a zero balance on a second processing platform; transferring said non-monetary data associated with said private label account to said second processing platform for association with said dual card account; and causing a dual card associated with said dual card account to be transmitted to account holder, said dual card and said dual card account being inactive until activated, as recited in claim 37.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

In the event that the Examiner decides to repeat the rejection in view of Fargo and Blagg, the Examiner is kindly requested to provide a **new non Final Office Action** that explains, **with particularity, why the missing descriptive matter is necessarily present.**

Dependent claims

Claims 2-18 depend from independent claim 1 and should be allowed for at least the reasons set forth above with respect to independent claim 1.

In addition, Applicants respectfully point out that the Office Action does not articulate how the cited portions of Fargo (alone or in combination with other art) could possibly teach or suggest subject matter recited in the dependent claims.

Accordingly, in the event that the Examiner decides to repeat the rejection in view of Fargo (alone or in combination with other art), the Examiner is kindly requested to provide a **new non Final Office Action** that explains, **with particularity**, how the cited portions of Fargo (alone or in combination with other art) teach or suggest all of the subject matter recited in the dependent claims.

CONCLUSION

For at least the reasons set forth above, Applicants respectfully submit that the present application is in condition for allowance. Accordingly, reconsideration and allowance of the present application are respectfully requested.

Because the reasons set forth above are sufficient to overcome the rejections set forth in the outstanding Office Action, Applicants do not address some of the assertions set forth therein and/or other possible reasons for overcoming the rejections. Nonetheless, Applicants reserve the right to address such assertions and/or to present other possible reasons for overcoming the rejections in any future paper and/or proceeding.

If the Examiner believes that a telephone interview would expedite the prosecution of this application in any way, the Examiner is cordially requested to contact the undersigned via telephone at (203) 972-0006, ext. 1014.

Respectfully submitted,

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Date

/Mark Steinberg/
Mark Steinberg
Registration No. 40,829
Buckley, Maschoff & Talwalkar LLC
Attorneys for General Electric Company
50 Locust Avenue
New Canaan, CT 06840
(203) 972-0006, ext. 1014